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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	M. Michael Pitts, Jr. et al.	DOCKET NO.:	111732.00012
SERIAL NO.:	10/796,814	EXAMINER:	William T. Leader
FILED:	March 9, 2004	ART UNIT:	1742

TITLE: CAPACITIVE ELECTROSTATIC PROCESS FOR INHIBITING THE FORMATION OF BIOFILM DEPOSITS IN MEMBRANE-SEPARATION SYSTEMS

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Gavin J. Milczarek-Desai
Quarles & Brady Streich Lang
One South Church Avenue, Suite 1700
Tucson, AZ 85701

CERTIFICATE OF MAILING

I hereby certify that on this 10th day of July, 2006, this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Katherine C. Maas

TRANSMITTAL OF REPLY BRIEF

Dear Sir:

Pursuant to the provisions of 37 C.F.R. 41.41, the appellant is hereby submitting three (3) copies of a Reply Brief to the Examiner's Answer in the above-captioned patent application.

Respectfully submitted,

Gavin J. Milczarek-Desai
Reg. No. 45,801
520) 770-8716 Telephone
(520) 770-2235 Fax

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TO THE COMMISSIONER FOR PATENTS

REPLY BRIEF

Dear Sir:

This is in response to the Examiner's Answer dated 15 May 2006.

REMARKS

In the first paragraph of the *Response to Argument* on Page 4 of the Examiner's Answer, the Examiner states the following:

> The claims of the instant application are not considered to be supported by the disclosure of 08/197,154 which issued as patent 5,591,317. While the '154 patent discloses the same electrostatic-field generator used in the instant method, the '154 application does not disclose a method for reducing the formation of biofilm deposits on a wall in a water system.

In response, the Board's attention is respectfully directed to the fact that the Examiner admits that the same electrostatic generator is disclosed in both the present application and the referenced patent case, yet the parent case does not disclose a method for reducing the formation of biofilm. Based on this admission alone, it is clear that the parent case cannot explicitly anticipate the claims on appeal. Thus, the Examiner contends that the claims on appeal are inherently anticipated because "The use of the electrostatic-field generator disclosed and claimed in the '317 patent is considered to **necessarily result** in reducing the formation of biofilm deposits." (Emphasis added; Examiner's Answer, page 4, last sentence).

Indeed, inherent anticipation requires that the missing descriptive material is "necessarily present," not merely probably or possibly present, in the prior art. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ 2d. 1597, (Fed. Cir. 2002) (citing *In re Robertson,* 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed.Cir.1999) (additional internal citations omitted). However, the appellant respectfully points out that there is no evidence of record that shows that a method for "reducing the formation of biofilm deposits on a wall in a water system" as claimed by appellant "necessarily" is present in the disclosure of the '317 patent. The mere assertion

by the Examiner that this is the case is not evidence to that effect. Hence, there is no inherent anticipation in this case. Furthermore, even if there was evidence of record that the present method did inherently result from use in water of the electrostatic generator described in the '317 patent, then the method claims under appeal also must be inherently described in the parent application for the purposes of the priority, thereby disqualifying the appellant's '317 patent as prior art.

In view of the foregoing and the arguments presented in appellant's Brief on Appeal, it is again submitted that the rejections of the claims should be reversed in their entirety.

Respectfully submitted,

Gavin J. Milczarek-Desai
Reg. No. 45,801

(520) 770-8700 Telephone
(520) 623-2418 Fax